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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,065	11/28/2001	Frank M. Zizzamia	098056/00120	1153

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KRAMER LEVIN NAFTALIS & FRANKEL LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
1177 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

EXAMINER
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RINES, ROBERT D

ART UNIT	PAPER NUMBER
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3623

NOTIFICATION DATE	DELIVERY MODE
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02/18/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

klpatent@kramerlevin.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/996,065	ZIZZAMIA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	R. David Rines	3623	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Withdrawal of final Office Action and Supplemental Non-Final Office Action**

[1] Applicant's request for reconsideration of the finality of the rejection of the Office Action mailed 2 September 2010 is persuasive. In consideration of Applicant's response to the Requirement for Information under 37 C.F.R. § 1.105 filed 15 June 2010 and the remarks filed 3 January 2010 the finality of the above noted previous office action is withdrawn. New Grounds of rejection are entered below.

### **Notice to Applicant**

[2] This communication is in response to the amendment after final filed 3 January 2011. Claims 1-20 are pending.

**Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

[3] Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: a processor configured to calculate a slope value for the plurality of predictive input variables and determining the relative importance of each of the variables by multiplying the deviance value for each variable by the calculated slope for each variable. These steps are identified as essential to the determination of the relative importance of at least one variable as disclosed in the Specification as originally filed (Specification; pages 4-5) and in response to the Requirement for Information under 37 C.F.R. § 1.105 filed 15 June 2010. For purposes of applying art, the subject claims are interpreted as including the noted essential steps/elements.

Claims 8-12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP

§ 2172.01. The omitted steps are: calculating a slope value for the plurality of predictive input variables and determining the relative importance of each of the variables by multiplying the deviance value for each variable by the calculated slope each variable. These steps are identified as essential to the determination of the relative importance of at least one variable as disclosed in the Specification as originally filed (Specification; pages 4-5) and in response to the Requirement for Information under 37 C.F.R. § 1.105 filed 15 June 2010. For purposes of applying art, the subject claims are interpreted as including the noted essential steps/elements.

### **Claim Rejections - 35 USC § 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based upon consideration of all of the relevant factors with respect to the claims as a whole, claims 1-20 are held to claim an abstract idea, and is therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

Claim 1 recites a system for calculating the relative importance of input variables to an overall insurance policy profitability score. The body of the claim recites a series of mathematical calculations beginning with “generate a multivariate statistical model...” and concluding with “calculate the relative importance of said one or more predictive input variables...”. The claim is

directed to the abstract idea of performing a series of mathematical calculations absent a specific practical application of the results of the calculations. While Examiner recognizes that the claim is generically directed to an insurance profitability scoring formula and further recites a system structure and therefore presents a man-made tangible embodiment of the invention, this embodiment is merely a computer performing calculations and the claim fails to provide a practical application of the output of the calculations. Examiner acknowledges that the claim concludes with the display of the results. However, the displaying calculation results fail to define a practice application of the output/results. As presented, the claim covers substantially all practical applications of the noted mathematical exception and thus preempts all practical applications of the claimed mathematical algorithm.

Similarly, claim 7 recites an analogous method for calculating the relative importance of input variables to an overall insurance policy profitability score. When analyzed in the manner described above with respect to claim 1, claim 7 also fails to specifically indicate a practical application of the recited mathematical manipulations and preempts all practical applications of the claimed algorithm.

Independent claims 13 and 17, when analyzed in the manner disclosed above with respect to claims 1 and 7 also fail to specifically indicate a practical application of the recited mathematical manipulations and preempts all practical applications of the claimed algorithm.

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Dependent claims 2-6, 8-12, 14-16, and 18-20 inherit and fail to remedy the deficiencies of their respective independent claims and when analyzed as a whole are held to be ineligible subject matter and are rejected under 35 U.S.C. 101 because the additional recited limitation(s) fail(s) to establish a practical application of the claimed mathematical algorithm.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[4] Previous rejection of claims 1-20 under 35 U.S.C. 103(a) as being unpatentable over combinations of Summerell et al. (United States Patent #5,937,387), Tanaka (United States Patent Application Publication #2002/0133441) and Hammond et al. (United States Patent #5,613,072) have been overcome by the amendment(s) to the subject claims and are hereby withdrawn.

**Allowable Subject Matter**

[5] Claims 1-20 are allowable under 35 U.S.C. 102 and 35 U.S.C. 103.

**REASONS FOR ALLOWANCE**

[6] The following is an examiner's statement of reasons for allowance:

**Claim 13**

The prior art of record neither anticipates nor supports a conclusion of obviousness with respect to the allowable subject matter of claim 13.

Applicant's remarks filed 27 July 2009 and Applicant's bona fide response to the Requirement for Information under 37 C.F.R. § 1.105 filed 15 June 2010 are compelling and commensurate with both the original disclosure and the claims as amended. Claim 13 is allowable over the art of record for the reasons discussed in the noted responses.

**Claims 1-12 and 14-20**

Claims 1-12 and 14-20 if amended to overcome the above rejections under 35 U.S.C. 112, second paragraph and 35 U.S.C. 101 are allowable over the prior art of record for reasons consistent with those identified with respect to claim 13.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. David Rines whose telephone number is (571)272-5585. The examiner can normally be reached on 8:30am - 5:00pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. David Rines/  
Primary Examiner, Art Unit 3623